



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,269	11/27/2001	Jeffrey J. Grainger	020313-000720US	2593

20350 7590 07/16/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

RONES, CHARLES

ART UNIT	PAPER NUMBER
----------	--------------

2175

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,269

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

Charles L. Rones

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable by Simpson et al. U.S. Patent No. 6,549,894 ('Simpson') in view of MacPhail U.S. Patent No. 5,107,419 ('MacPhail').

Simpson discloses:

As to claim 1,

storing a plurality electronic documents related to a patent application in a database accessible to a server system, wherein each of said plurality of electronic documents has a document type and wherein said plurality of stored documents includes at least one document having a first document type and at least one document having a second document type; See 2:1-55; 4:34-67;

receiving a signal at said server system indicating said predetermined event has occurred; See 3:4-45; 6:30-45;

Simpson discloses the claimed invention except for the storing a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type. MacPhail teaches that it is known to store a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type. It would have been obvious to one having ordinary skill in the art at the time the invention was made to store a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type as taught by MacPhail since MacPhail states at column 1, lines 55-67; and column 2, lines 1-3 that such a modification would deletion of documents that are no longer needed from the system as soon as possible;

after receiving said signal, implementing said rule to delete documents of said second type in said database that are related to said patent application but not delete documents of said first type that are related to said patent application; See 1:22-44; 2:1-55; MacPhail: Abstract; 1:59-67; 2:1-4.

As to claim 2, 12, and 13,

wherein said predetermined event is either grant of a patent from said patent application or payment of an issue fee for said patent; See 3:4-45.

As to claim 3,

wherein said predetermined event is a signal received from an authorized client system; See 5:35-48.

As to claim 4,

wherein said first document type is a filed patent application and wherein said second document type is a draft patent application; See 1:65-67; 2:1-36; 4:45-67.

As to claims 5 and 14,

wherein said patent application is assigned to a first technology developer and wherein said signal is generated by a client system associated with said first technology developer; See 4:1-67; 5:5-67; 6:1-45.

As to claim 6,

wherein said client system is associated with a patent practitioner that represents said first technology developer; See 4:1-67.

As to claims 7 and 15,

wherein said executing step is in response to receipt of said signal; See 4:1-67; 5:5-67; 6:1-45.

As to claim 8,

wherein said plurality of electronic documents also includes at least one document having a third document type, said third document type being associated with unofficial notes from an inventor of said patent application to an practitioner, and wherein said rule causes said server to delete documents of said third type associated with said patent application during said executing step; See 1:65-67; 2:1-36; 4:45-67.

As to claim 9,

wherein said plurality of electronic documents also includes at least one document having a fourth document type, said fourth document type being associated with versions of patent papers stored in said database in an image file format that were generated by a patent office, and wherein said rule does not cause said server to delete documents of said fourth type associated with said patent application during said executing step; See 1:65-67; 2:1-36; 4:45-67; See also corresponding response from claim 1.

As to claim 10,

allowing a client system to create and/or modify said rule that defines specific document types to be deleted and/or specific types of documents to be saved in response to receiving said signal; See 1:65-67; 2:1-36; 4:45-67; See also corresponding response from claim 1.

As to claim 11,

storing a plurality electronic documents related to a patent application in a database accessible to a server system, wherein each of said plurality of electronic documents has one or more attributes associated therewith; See corresponding response above in claim 1;

storing a rule in said database that determines specific electronic documents to be deleted from said database in response to a predetermined event occurring related to prosecution of said patent application, wherein said rule deletes documents having a predetermined attribute; See corresponding response above in claim 1;

receiving a signal at said server system indicating said predetermined event has occurred; See corresponding response above in claim 1;

after receiving said signal, implementing said rule to delete documents from said database that are related to said patent application and have said predetermined attribute but does not delete documents from said database that are related to said

patent application and do not have said predetermined attribute; See corresponding response above in claim 1.

As to claim 16,

(a) a processor; (b) a database; and (c) a memory for storing a program; wherein said processor is operative with said program to: ; See Fig, 5C; 3:1-35;

(i) store, in said database, information related to a patent application, said information including at least an invention disclosure, a patent application as filed in an official patent office, unofficial documents related to said patent application and one or more papers generated by said official patent office that are related to said patent application; See 3:4-35; 4:34-67; 7:14-34;

(ii) in response to an indication from said official patent office that said patent application has been allowed, receive an instruction to categorize said patent application as allowed in said database and automatically delete said unofficial documents related to said patent application from said database; See 3:4-35; 4:34-67; 7:14-34; MacPhail: 1:55-67; 2:1-3.

As to claim 17,

wherein said processor is operative with said program to allow a client system to set-up workflow rules related to defining specific types of documents to be deleted and/or specific types of documents; See 7:14-34; MacPhail: 1:55-67; 2:1-3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Rones whose telephone number is 703-306-3030. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.



Charles L. Rones
Primary Examiner
Art Unit 2175

July 14, 2003